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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,975	08/21/2001	Kazuhiro Fujimaki	003510-110	6820

7590

08/25/2003

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/25/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/932,975

Applicant(s)

FUJIMAKI ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-10 in Paper No. 9 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 5-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 11, 13-16 of copending Application No. 10/080,654 (US 2002/0182539 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because Fujimaki et al. claim a negative image-recording material for heat-mode exposure, which is able to form images by heat-mode exposure comprising an alkaline

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aqueous soluble polyurethane resin having at least one or more side-chain branches of general formulae (1) to (3), a photo-thermal converting agent and a compound which generates a radical through heat-mode exposure to light of a wavelength which wavelength can be absorbed by the photo-thermal converting agent (claim 1). The alkaline aqueous soluble polyurethane resin meets the present limitations for the polymer compound (A). The photothermal converting agent of Fujimaki et al. can be a cyanine dye (claim 11), which meets the present limitations for the photothermal conversion agent (B) of the present application. The radical generating compound of Fujimaki et al. can be an onium salt (claim 13), specifically an iodonium salt, a diazonium salt or a sulfonium salt (claim 14) which meets the present limitations for the onium salt compound (C). The negative image-recording material of Fujimaki et al. can further contain a radical polymerizing compound (claim 15), which meets the present limitations for the same. The weight average molecular weight of the polyurethane resin is at least 10,000 (claim 9). Fujimaki et al. do not claim the carboxyl acid group content however the carboxyl acid group content of polyurethane resin of Fujimaki et al. is expected to overlap with the required range of the present application because one of the four required polymers comprising a group of general formulae (1) to (3) is specifically claimed by Fujimaki et al. Further the weight average molecular weight of the polyurethane resin of Fujimaki et al. overlaps with the required range. Therefore absent any contrary evidence, one of ordinary skill in the art would expect the carboxyl acid group content of the polymers to overlap as well. Fujimaki et al. do not claim a lithographic printing plate comprising the negative image-recording material or a process of making an image using the printing plate however it would have been obvious

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to one of ordinary skill in the art to use the negative image-recording material to make a lithographic printing plate by coating the negative image-recording material on an appropriate support. The negative image recording material comprises a photothermal converting agent such as a cyanine dye, which is capable of absorbing infrared radiation and converting the absorbed radiation into heat. Therefore it would have been obvious to expose the obtained plate with an infrared light source and develop the plate to remove the non-exposed areas using an aqueous alkaline developer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-6, 8-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-8, 13-16 of copending Application No. 10/223,700 in view of Aoshima (US 6,566,035 B1). In copending application 10/223,700, (US 2003/0146965 A1) Fujimaki et al. claim a negative image recording material on which an image is formable by exposure, comprising a specific polymer compound having at least one of the groups represented by the general formulae (1) to (3) in the side chain thereof (claims 1 and 8). The general formula (1) to (3) are identical to the general formulae (1) to (3) of the present application. The specific polymer is aqueous alkaline solution soluble (claim 1), contains at least 1.5 meq/g of the carbon-carbon double bond in the side chain thereof (claim 4). The principal chain structure of the polymer can be a poly(meth)acryl resin, a polystyrene resin, a polyurethane resin or an acetal-denatured polyvinyl resin (claim 7) and has a weight average molecular weight of 6,000 or more (claims 13-14). Fujimaki et

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al. do not claim the carboxyl acid group content of the specific polymer however the carboxyl acid group content of specific polymer of Fujimaki et al. is expected to overlap with the required range of the present application because three of the possible polymers comprising a group of general formulae (1) to (3) is specifically claimed by Fujimaki et al. Further the weight average molecular weight of the specific polymer in Fujimaki et al. fully encompasses the weight average molecular weight range required in the present application. Therefore absent any contrary evidence, one of ordinary skill in the art would expect the carboxyl acid group content of the polymers to overlap at the very least. The negative image recording material further comprises a light-heat converting agent (claim 1) which meets the limitations for the photothermal conversion agent (B). The material comprises a radical-polymerizable compound (claim 2), which meets the present limitations for the same. The material comprises a compound that generates radicals by exposure using light of a wavelength absorbable by the light-heat converting agent (claim 1). Fujimaki et al. do not claim specific compounds however it would have been obvious to use conventional radical generating compounds such as the onium salts of Aoshima. The material of Aoshima is negative working and acts as a precursor to negative type lithographic printing plate. The onium salt of Aoshima functions not as an acid generating agent but an initiator of radical polymerization and can be an iodonium salt, a diazonium salt or a sulfonium salt (column 10, lines 45-65). Therefore it would have been obvious to one of ordinary skill in the art to make the negative image recording material of Fujimaki et al. wherein the material comprises a conventional onium salt as the radical generating compound based on the teachings of Fujimaki et al. and Aoshima with reasonable expectation of obtaining a negative-type

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image recording material capable of forming an image upon exposure to light. Further it would have been obvious to expose the plate of Aoshima, wherein the plate comprises the negative image forming material on a support, using light of a wavelength absorbable by the light-heat converting agent and to develop the exposed plate using an aqueous alkaline developer based on the teachings of Fujimaki et al.

This is a provisional obviousness-type double patenting rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 2003/0073032 A1, Aoshima teach a negative planographic printing plate.

b. In US 2002/0177074 A1, Hoshi et al. teach a planographic printing plate precursor and planographic printing method.

c. In US 2002/0048722 A1, Aoshima teach a planographic printing plate and method of producing the same.

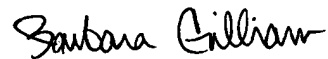
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Barbara Gilliam
Examiner
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